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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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**DATE MAILED:**

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/910,980</b>	Applicant(s) <b>Thomas D. Petite</b>
	Examiner <b>Douglas X. Rodriguez</b>	Group Art Unit <b>2876</b>



Responsive to communication(s) filed on Apr 19, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-16 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-16 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is approved disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None  of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received:

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

... SEE OFFICE ACTION ON THE FOLLOWING PAGES ...

## DETAILED ACTION

1. Acknowledgment is made of applicant's amendment filed April 19, 1999. Claims 1,  
2, 12 and 14 have been amended, claim 16 has been added. Currently claims 1-16 are pending in  
this application.

### *Claim Rejections - 35 USC § 112*

2. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for  
failing to particularly point out and distinctly claim the subject matter which applicant regards  
as the invention.

3. Claim 16 recites the limitation "the track one and track two data" in line 6. There is  
insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all  
obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1-8, 12-16 drawn to the system and claims 9-11 drawn to the method are rejected under 35 U.S.C. 103(a) as being unpatentable over Gutman et al. U.S. Patent No. 5,221,838.

Gutman discloses a system for transmitting billing information to a communication device comprising: receiving means (524) operatively associated with the communication device for receiving data (fig. 5C), and a remote access unit (520) having a memory (206) configured to store user identification data (column 7, lines 54-56) and a low-power transmitter (224) adapted to transmit the user identification data to the receiving means (column 8, lines 50-52; column 12, lines 64-68; column 13, lines 1-5; column 14, lines 17-68; column 15, lines 1-5).

Gutman differs from the claimed invention in that it fails to specifically disclose that the data transmitted is by means of electromagnetic waves. Gutman does however state that the system (100) may be capable of transmitting a message using conventional techniques such as RF communication, IR communication, and microwave communication (column 8, lines 43-47). It is well known in the art that electromagnetic waves are waves characterized by variations of electric and magnetic fields. Electromagnetic waves are known as radio waves, heat rays, light rays, etc., depending on their frequency. Since Gutman clearly states that radio frequency (RF) communication can be used to transmit data, Gutman although not explicitly stated, teaches the claimed limitation for electromagnetic waves.

Gutman also differs from the claimed invention in that it fails to specifically state that the remote access unit (520) has a manually-operated transmit button to controllably retrieve user identification data from the memory and transmit the user identification data from the transmitter. Gutman does however disclose the presence of a keyboard (102), function keys (104) and buttons (106) for receiving user input (column 4, lines 55-58). Gutman also discloses the step of transmitting as well as receiving data from a financial institution (column 4, lines 39-42 and column 8, lines 43-49). Since it is notoriously well known in the art, that in order to transmit data or to confirm the transmission of data, some switch needs to be depressed (e.g., enter button, transmit button), the presence of a transmit button in Gutman's system would have been obvious to one of ordinary skill in the art at the time of the invention. This would have been done with the purpose of permitting the user of the system to confirm or edit the order or transaction before completing the transaction.

In regards to claim 2, wherein it is claimed that the user identification data includes a financial account number, Gutman teaches such claimed limitation (column 7, lines 54-57).

As for claim 3, wherein it is claimed that the user identification data includes a long distance billing account number, Gutman fails to teach such limitation, Gutman simply discloses the transmission of financial data. However, to transmit any other kind of information besides financial data, would have been an obvious expedient to an already well known procedure and thus obvious to one of ordinary skill in the art at the time of the

invention. For example, this would have been done with the purpose of using the system not only as a checkbook or an electronic wallet, but also as a calling card.

As for claims 4 and 11, wherein it is claimed that the receiving means receives electromagnetic data in a wavelength selected from the group consisting of: radio frequency; ultrasonic; and infra-red, Gutman teaches such claimed limitation (column 8, lines 43-47).

In regards to claims 5 and 6, wherein it is claimed that the electronic circuitry that carries out the functionality of the remote access unit is contained within a single integrated circuit and that the remote access unit includes means for formatting the user identification data into a data packet for transmission to the receiving means, Gutman teaches all such claimed limitations (column 8, lines 47-58).

As for claim 8, wherein it is claimed that the communication device is one selected from the group consisting of: a telephone, a modem, an ISDN converter, and a cable box, such limitations are met by Gutman (column 9, lines 10-13).

In regards to claim 10, wherein it is claimed the step of authorizing use of the communication device based upon information received in response to the step of transmitting the extracted information for authorization, Gutman teaches such limitation (column 7, lines 54-68; column 8, lines 17).

*Response to Arguments*

6. Applicant's arguments filed April 19, 1999 have been fully considered but they are not persuasive.

4        Applicant mainly contends that the reference cited (hereinafter Gutman), fails to teach  
5        that the system used is a low-power RF transmitter. Such argument is traversed. Although  
6        Gutman fails to specifically state the presence of an RF transmitter, Gutman discloses that the  
7        information transmitted, can be by means of an RF link (column 8, lines 43-47). Therefore,  
8        by having the capability of transmitting information via an RF link, the placing of an RF  
9        transmitter in Gutman's system would have been obvious to one of ordinary skill in the art at  
10      the time of the invention.

11        Applicant also contends that Gutman fails to disclose the "communication device" of  
12      the claimed invention. The communication device being capable of communicating across a  
13      telecommunication link and being either a telephone, a modem, an ISDN converter, or a cable  
14      box converter. Such argument is traversed. Although Gutman does fail to disclose that the  
15      communication device could be either a telephone, a modem, an ISDN converter or a cable  
16      box converter, Gutman does state that the communication device could be a third party that  
17      provides a service as part of the transaction (column 14, lines 64-68). It is notoriously well  
18      known that telephones, modems, cable boxes, etc., are all devices that provide some type of  
19      service to the customer. To simply modify Gutman's establishment which provides a specific

service and to make it a telephone, modem or cable box, would have been an obvious expedient to an already well known and commonly practiced process and therefore an obvious modification to one of ordinary skill in the art at the time of the invention.

*Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Benton U.S. Patent No. 4,454,414. Discloses a funds transfer system using optically coupled portable modules.

Stuckert U.S. Patent No. 4,277,837. Discloses a personal portable terminal for financial transactions.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to

37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

4  
5 9. Any inquiry concerning this communication or earlier communications from the  
6 examiner should be directed to Douglas X. Rodriguez whose telephone number is (703) 308-  
7 4081.

8 If attempts to reach the examiner by telephone are unsuccessful, the examiner's  
9 supervisor, Donald T. Hajec, can be reached on (703) 308-4075. The fax phone number for  
10 this Group is (703) 308-7723.

11 Communications via Internet e-mail regarding this application, other than those under  
12 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and  
13 should be addressed to [don.hajec@uspto.gov].

14 All Internet e-mail communications will be made of record  
15 in the application file. PTO employees do not engage in Internet  
16 communications where there exists a possibility that sensitive  
17 information could be identified or exchanged unless the record  
18 includes a properly signed express waiver of the confidentiality  
19 requirements of 35 U.S.C. 122. This is more clearly set forth in  
20 the Interim Internet Usage Policy published in the Official

1 Gazette of the Patent and Trademark on February 25, 1997 at 1195  
2 OG 89.

3 10. If the applicant wishes to send a fax transmission which may be intended as non-official for  
4 consideration by the examiner for interviews or other purposes, the fax should be clearly marked:

5 1.) "DRAFT" and/or "COURTESY COPY" on the fax cover sheet along with a statement  
6 "DELIVER DIRECTLY TO EXAMINER", and

7 2.) Should be unsigned by the attorney or agent.

8 This will ensure that such an un-official fax transmission will not be entered into the application.

9 *Papers related to the application may be submitted to Technology Center 2800 by fax  
10 transmission. Papers should be faxed to Technology Center 2800 via the PTO Fax machine  
11 located in Crystal Plaza 4. The form of such papers must conform with the notice published in  
12 the Official Gazette, 1096 OG 30 (November 15, 1989). The CP4 Fax Machine numbers are:  
13 (703) 308-7722, (703) 308-7724, (703) 308-7382, (703) 305-3431, and 305-3432.*

14 Any inquiry of a general nature or relating to the status of this application should be  
15 directed to the Group receptionist whose telephone number is:

16 (703) 308-0956.

17

18

19

20 Douglas X. Rodriguez

21 Patent Examiner

22 GAO 2876

23 June 8, 1999

  
**MICHAEL G. LEE**  
**Primary Examiner**